

Application No: 10/719,276 Docket No.: Q169-US1

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REMARKS

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Claims 1-3, 5, 7-22, 24-25, 27 were previously presented. Claims 4, 6, 23, 26, and 28-138 were previously canceled. Accordingly, claims 1-3, 5, 7-22, 24-25, and 27 are pending examination.

**Rejection of Claim 1 Under 35 USC §103(a)**

Claims 1 stands rejected under 35 USC §103(a) as being unpatentable over U.S. Patent Publication No. 2003-0211383 A1 (Munshi) in view of U.S. Patent No. 5,716,728 (Smesko). The rejection argues that the result specified in the claim is inherently achieved since Munshi teaches the use of a LiBOB salt.

Smesko teaches that the electrolyte is important to operation of the disclosed battery in the Abstract; C4, L53-56; and C5, L8-12. Smesko also teaches that the salt in the electrolyte is an **inorganic** salt at C4, L13; C14, L18; and C4, L35. However, the LiBOB on which the Office Action relies is an **organic** salt as Munshi teaches when classifying LiBOB an **organoborate** salt throughout the specification.

Since Smesko teaches that electrolyte selection is important and that the electrolyte includes inorganic salts but the LiBOB taught in Munshi is an organic salt, an inventor would not be motivated to modify a battery using LiBOB as a salt with the disclosure of Smesko. For this reason alone, the cited art does not support an obviousness rejection and claim 1 is patentable over the combination of Smesko and Munshi.

Additionally, a *prima facie* case of obviousness requires “a reasonable expectation of success” when combining references. See MPEP 706.02(j). The Office Action argues it would have been obvious to combine the cited art in order to achieve the improved energy density and gravimetric energy taught by Smesko. However, Smesko provides no teaching or suggestion that these benefits can be achieved when an organic salt is employed. As a result, there is no reason to expect that using Smesko to modify a battery with a LiBOB salt would continue to produce the advantages cited by Smesko. As a result, the cited art does not provide the expectation of success necessary for a proper obviousness rejection. For this reason alone, the cited art does not support an

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obviousness rejection and claim 1 is patentable over the combination of Smesko and Munshi.

Additionally, Applicant does not concede the Munshi is prior art for the current Application. Applicant reserves the right to present evidence that Munshi is not available as prior art for the current Application.

**Second Rejection of Claim 1 Under 35 USC §103(a)**

Claim 1 also stands rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 5,462,566 (Skotheim) in view of Smesko.

The Office Action argues that it would have been obvious to modify the Skotheim battery with the anode-to-cathode capacity ratio disclosed in Smesko. However, this modification does not result in the claimed device. Skotheim teaches secondary batteries (See title, etc). Because changing the anode-to-cathode capacity ratio as suggested in the Office Action does not change battery chemistry from a secondary battery to a primary battery, the result of the suggested modification is still a secondary battery. However, applicant is claiming primary batteries. Since primary batteries are different from secondary batteries, claim 1 is patentable over the cited art. For this reason alone, the cited art does not support an obviousness rejection and claim 1 is patentable over the combination of Smesko and Skotheim.

**Argument in Office Action**

The Office Action appears to be addressing the arguments directed to Skotheim when stating that "Secondary (rechargeable) batteries can be used as primary batteries (non-chargeable) batteries if the batteries are not subject to recharging." The Applicant does not understand how this statement relates to the claims in the current Application. It appears the Office Action is arguing that one of Skotheim's secondary batteries becomes a primary battery if a user decides to charge and discharge it only once. However, since the primary or secondary nature of a battery is determined by battery chemistry, the failure of a user to repeatedly discharge a secondary battery does not convert secondary battery to a primary battery. As a result, it seems unlikely that the above argument is the intent of the Office Action. Accordingly, if this line of reasoning is pursued in the next

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Office Action, the Examiner is very respectfully requested to elaborate on how this statement relates to the pending issues in order to provide the Applicant with a full opportunity to address this issue.

**Allowable Subject Matter**

The Office Action indicates that claims 10 and 11 would be allowable if rewritten in independent form. The Applicant is grateful for this indication of allowable subject matter.

**Claims 2-3, 5, 7-9, 12-22, 24-25, and 27**

Claims 2-3, 5, 7-9, 12-22, 24-25, and 27 each depends from claim 1. Since claim 1 is believed to be in condition for allowance, these claims are also believed to be in condition for allowance.

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**CONCLUSION**

The Examiner is encouraged to telephone or e-mail the undersigned with any questions.

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